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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SecureCar, Inc.¹

Serial No. 76464131

Todd C. Steckler of Morgenthau & Greenes, LLP for
SecureCar, Inc.

Steven R. Fine, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before Hairston, Chapman and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On November 5, 2002, SecureCar, Inc. (applicant),
through its predecessor, applied to register the mark
SECURECAR, in typed form, on the Principal Register for

¹ The application was originally filed in the name of Empire International, Ltd. The application was subsequently assigned to SecureCar, Inc. See Reel/Frame No. 2635/0209.

services identified as the "transportation of passengers by armored, bulletproof and other security-enhanced vehicles" in International Class 39. The application (Serial No. 76464131) was based on an allegation that the mark was first used anywhere and in interstate commerce on October 8, 2001.

The examining attorney refused registration on the ground that the mark was merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), because "the attribute described by the term SECURECAR is the armored, bulletproof and otherwise security-enhanced vehicles in which applicant transports passengers." Office Action dated June 6, 2003 at 1. Applicant, on the other hand, argues that an "armored car is just that, a car fortified with armor plating. A secure car, on the other hand, requires a broad panoply [of] services that are not immediately apparent from the definitions of secure." Appeal Brief at 11.

When the examining attorney made the refusal final, applicant appealed to this board.²

We affirm.

² On January 22, 2004, applicant withdrew its request for an oral hearing.

For a mark to be merely descriptive, it must immediately convey knowledge of the ingredients, qualities, or characteristics of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980); In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"). Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

We must consider whether the mark in its entirety is merely descriptive. P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 545-46 (1920). However, "[i]t is perfectly acceptable to separate a compound mark and discuss the implications of each part thereof ... provided that the ultimate determination is made on the basis of the mark in its entirety." In re Hester Industries, Inc., 230 USPQ 797, 798 n.5 (TTAB 1986).

The following evidence of record supports our conclusion that the term SECURECAR is merely descriptive

for the transportation of passengers by armored, bulletproof and other security-enhanced vehicles.

An article from the *San Antonio Express-News*, dated November 10, 1996, contained the headline "Kidnappings for ransom spark interest in armored cars." The text of the article goes on to report that "'[m]any armored cars are obvious and that makes you of interest to the casual observer,' Cash said by telephone. 'And once you start down the road with a **secure car**, you then need a secure chase car, which is of little use without an advance car as well.'" An Internet article from *Inside Technology* is entitled "Booming need for **secure cars**." The article reports that "General Motors and Ford enter armored vehicle market in response to growing demand since 9/11." The opening sentence of the report states "Cars that can be hermetically sealed or [that] withstand shots from a .44 caliber Magnum are no longer the stuff of James Bond movies - they are a commodity in greater demand following the Sept. 11 terror attacks. So Detroit automakers are creating cars specifically for the limited but expanding armored vehicle market."

Advertising that applicant submitted describes its services as follows: "When security concerns dictate a higher standard for chauffeured transportation, call

SecureCar, Empire International's Secure Transportation Division, -- the industry's only worldwide Security Chauffeur and Secure Vehicle service." Among the features and services that SecureCar offers are:

Secure Luxury Sedans & SUVs including:

- Safety vehicles (US only) - with run flat tires and security glass
- Light, Medium, and Heavy Armored Luxury Sedans - (US and Worldwide) with run-flat tires, composite security glass, integrated armor plating, and self-sealing fuel tanks

The examining attorney also submitted a definition from *The American Heritage Dictionary of the English Language* (3rd ed. 1992) of "secure" as "free from danger or attack: a secure fortress." Applicant maintains that "the 'secure' characteristic is an absolute, as prescribed by the words 'free from' rather than 'freer from' in the definition relied upon [by] the Examining Attorney." Applicant's Brief at 9 (emphasis in original). Applicant concludes that an "armored car may be safer than a normal car, but certainly is not free from danger or attack." Id. Applicant's mechanical reading of the definition of the term "secure" is not supported by the example in the definition as "a secure fortress" inasmuch as history undoubtedly records the fall of many "secure fortresses."³

³ Another definition of "secure" is "free from or not exposed to danger or harm; safe." *The Random House Dictionary of the*

Even applicant itself uses the term "secure" in a way that seems remarkably similar to the way the examining attorney maintains the word would be interpreted by prospective purchasers. Applicant's "Secure Transportation Division" features "Secure Luxury Sedans & SUVs." It is unlikely that applicant is guaranteeing that these secure luxury sedans and SUVs are absolutely free from danger.

Applicant's services involve transporting passengers in armored, bulletproof and security-enhanced vehicles. Applicant itself refers to its Secure Transportation Team as providing "Secure Luxury Sedans & SUVs." These vehicles can accurately be described as secure cars.⁴ As noted earlier, we must view the term in relation to these services and not in the abstract. When we consider the term in association with the transportation of passengers

English Language (unabridged) (2d ed. 1987). We take judicial notice of this definition and the additional definition of the term "fortify" that the examining attorney made of record in his brief. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). While there can be a philosophical discussion as to whether mortals can ever be "safe" or "not exposed to danger or harm," clearly in the vernacular, we use the term in a less absolute sense than applicant associates with the term.

⁴ There is apparently no dispute that the word "car" is descriptive for applicant's services. We take judicial notice of the following definition of "car" as "an automobile." *The Random House Dictionary of the English Language (Unabridged)* (2d ed. 1987). Applicant's services clearly involve the use of cars/automobiles. See Applicant's Reply Brief at 2 ("Therefore, the fact that SecureCar's automobiles may be armored...").

in armored and security-enhanced vehicles, the term SECURECAR would be immediately describe a feature of those services, i.e., the cars are armored and/or security enhanced. The evidence of record supports this meaning of the term secure car with armored vehicles.

While applicant argues there is a distinction between the use of "armored car" and "secure car" in the articles, any difference would not mean that the term is suggestive rather than descriptive of applicant's services. Assuming that there is a difference between the meanings of the terms, applicant's services are not limited to transporting passengers in armored cars. Its services also involve the use of "other security-enhanced vehicles," which would be covered by the definition of "secure" and would be effectively described as "secure cars." The evidence does show that when potential purchasers encounter the mark in relationship with applicant's services that are advertised as transporting passengers in secure luxury sedans and SUVs, they will immediately know that these cars are security-enhanced or secure cars.

While applicant points out that its services involve several features, for a mark to be merely descriptive, a term need only describe a single significant quality or property of the goods. In re Gyulay, 820 F.2d 1216, 3

USPQ2d 1009, 1009 (Fed. Cir. 1987); Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). Also, while not raised as an issue, the combining of two descriptive words into one word without a space normally does not result in a non-descriptive term. See In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1017 (Fed. Cir. 1987) (SCREENWIPE generic for a wipe for cleaning television and computer screens); Abcor Dev. (GASBADGE at least descriptive for gas monitoring badges; three judges concurred in finding that term was the name of the goods); Cummins Engine Co. v. Continental Motors Corp., 359 F.2d 892, 149 USPQ 559 (CCPA 1966) (TURBODIESEL generic for a type of engine); In re Orleans Wines, Ltd., 196 USPQ 516 (TTAB 1977) (BREADSPRED descriptive for jams and jellies that would be a spread for bread); In re Perkin-Elmer Corp., 174 USPQ 57 (TTAB 1972) (LASERGAGE merely descriptive for interferometers utilizing lasers). In this case, whether spelled SECURE CAR or SECURECAR, the term would convey the same meaning to prospective purchasers of transportation services involving the use of armored, bulletproof and security-enhanced vehicles.

Applicant has included with its brief a list of registrations that included the registration number, the typed term in the mark, and the identification of goods or

services. Normally, we would not consider lists of registrations. In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974) ("[T]he submission of a list of registrations is insufficient to make them of record"). However, the examining attorney has not objected to the list and he has discussed these registrations so we will consider the information stipulated into the record. The examining attorney has pointed out that several of these registrations are on the Supplemental Register. Others are expired.⁵ Ultimately, we do not find these registrations persuasive. Lists of marks with goods and services only do not provide much information to form a conclusion as to how the Office treated a particular term. The Federal Circuit has explained that "[e]ven if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Here, the registrations to which applicant refers are for a variety of goods and services. They apparently include

⁵ The examining attorney responded to applicant's list by referring to several other marks in his brief that are registered on the Supplemental Register or with disclaimers. Applicant in its Reply Brief at 5 n.1 discusses some of these registrations. Again, because applicant does not object we will consider the information that the examining attorney submitted in his brief as stipulated into the record.

registrations on the Principal Register, but also on the Supplemental Register. Obviously, each application must be determined on its own record. In the present case, the record supports the conclusion that applicant's mark SECURECAR is merely descriptive for the identified services.

Decision: The refusal to register is affirmed.